REMARKS

Reconsideration of this application and the rejection of claims 1, 3, 4, 7, 9, 10, 13-17 and 20-22 are respectfully requested. Applicant has attempted to address every objection and ground for rejection in the Office Action dated November 9, 2009 (Paper No. 20091030) and believes the application is now in condition for allowance. Alternatively, the claims are placed in better condition for allowance. In this regard, the claims have been amended to more clearly describe the present invention.

Claim 21 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite because claim 21 recites that "the body defines at least one additional opening" where independent claim 21 states that the body is "aperture-free" sidewall. Applicant has cancelled claim 21 and therefore respectfully requests that the rejection of claim 21 be withdrawn.

Claims 1, 3, 4, 7 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of U.S. Patent No. 3,848,510 to Johnson and U.S. Patent No. 6,032,399 to DePoe. Applicant disagrees with and traverses this rejection for the following reasons.

Johnson discloses a minnow retrieving device including a trap 4 having a circular sidewall that defines several apertures 18. The trap 4 is rotatably connected to a handle 2. DePoe discloses a fishing net having a telescoping handle.

In contrast, amended claim 1 recites, among other things, a handheld fish catching device including "a handle including a first handle end and an opposing second

handle end" and "a body wherein the body is a tube having a solid, side wall, unitary construction, a first body end and an opposing second body end . . . said second body end including a fixed end wall constructed to prevent the fish from exiting or being removed from said second body end, said fixed end wall defining a single, second opening having a second diameter, said second diameter being less than said first diameter and less than the width of the fish to prevent the fish from exiting through said second opening, wherein said first handle end is non-rotatably connected to a point on along an outer surface of said body about midway between said first body end and said second body end and is constructed to prevent the fish from entering said first handle end." The combination of Johnson and DePoe fails to disclose or suggest such subject matter.

The handle in Johnson is attached to an end of the trap 4 so that the trap swings to "a vertical position in which the minnow is presented head down and cannot escape" (Col. 3, lines 33-37). Johnson also specifically claims that the "trap [is] pivotally connected to one end of the handle so that it will rest horizontally on the bottom of the bucket." (see Claim 1). Connecting the handle in Johnson to a middle portion or a point midway between the ends of the trap would allow the front end of the trap to rotate either upwardly or downwardly relative to the handle based on the positioning of the fish (i.e., weight distribution of the fish) inside the trap. If the front end of the trap rotates downwardly, then the fish will fall out of the trap and the process will have to be repeated. The only way to prevent such a loss in Johnson is to pivotally attach the handle to the open end of the trap.

DePoe discloses a handle that is attached to a ring for holding a net and therefore does not teach attaching a handle to a midway point along an outer surface of a tubular body. DePoe therefore does not remedy the deficiencies of Johnson.

For at least these reasons, Applicant submits that amended claim 1, and the claims that depend therefrom, are each patentably distinguished over the combination of Johnson and DePoe and in condition for allowance.

Claims 10, 13, 17, 20 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Johnson, DePoe and U.S. Patent No. 3,541,722 to Garrison. Applicant disagrees with and traverses this rejection for the following reasons.

The Examiner states that the combination of Johnson and DePoe teaches the subject matter of claims 10, 13, 17, 20 and 22 except for a fish catcher having an aperture-free sidewall. The Examiner therefore relies on Garrison to disclose this subject matter.

Garrison discloses a minnow trap including a funnel 21 attached to an end of a body 10. An opposing end of the body is open to allow a fish to enter through the funnel 21 and then be hooked and removed from the opposing end of the body as shown in FIG. 2.

Applicants submit that a person of ordinary skill in the art would not be motivated or have reason to combine Johnson and DePoe with Garrison to achieve the claimed invention where there is no reason to make such a combination. Both Johnson and DePoe disclose catching devices having an open first end and a generally closed

second end where a fish can enter the first ends of the devices but cannot exit through the second ends of the devices. Thus, fish that are caught in the trap in Johnson or the net in DePoe can be dumped into a user's hand without the possibility of losing the fish through the second end.

Garrison specifically discloses a minnow trap having an open first end and an open second end. The central portion of the device in Garrison is aperture-free because it guides the fish to the second end.

A person of ordinary skill in the art would not combine Johnson and DePoe with Garrison for two reasons. First, both Johnson and DePoe disclose fish catching devices having an open end and an opposing closed second end. Garrison, on the other hand, discloses a minnow trap having two open ends, which teaches away from the devices in Johnson and DePoe. Second, both Johnson and DePoe disclose devices having an aperture-free sidewall and a second end having a single, unobstructed opening for draining water. In contrast, the minnow trap in Garrison has a solid sidewall with only one opening at the fish removing end of the trap (see FIG. 2). This opening is not unobstructed because a portion of the fish fits into the opening so that a hook can be placed through the fish. Thus, Garrison teaches away from a second end having an single opening for quickly draining water from the trap as in Johnson and DePoe. A person of ordinary skill would therefore not be motivated to combine the teachings of Johnson, DePoe and Garrsion to achieve the claimed invention.

Nevertheless, even if combined, the combination of Johnson, DePoe and Garrison fails to disclose or suggest the subject matter of claims 10, 13, 17, 20 and 22.

Amended claim 10 recites, among other things, a handheld fish catching device including "a handle with a slip resistant surface, said handle including a first handle end and an opposing second handle end" and "a body of unitary construction, said first and second handle ends being on a same side of said body, said second handle end being non-rotatably connected to a point in a middle portion of said body having a uniform diameter . . . said second end of said body having a fixed end wall defining a single, unobstructed second opening having a second diameter that is less than the first diameter and less than the width of the fish to prevent the fish from exiting or being removed from said second end of said body."

Similarly, amended claim 13 recites, among other things, a handheld fish catching device including "a handle having a first proximal end and a second distal end" and "a unitary body having a uniform diameter and defining a longitudinal axis, said first proximal end of said handle being non-movably connected to a middle portion of a perimeter of said body along an outer surface thereof and being constructed to prevent a fish from entering said handle . . . said body having a first end, an opposing second end and a solid, aperture-free side wall between said first end and said second end . . . wherein said second end includes a fixed end wall defining a single, second unobstructed opening having a second diameter that is less than the first diameter and less than the

width of the fish to prevent the fish from exiting or being removed from said second end of said body."

Amended claim 20 also discloses similar subject matter. Specifically, amended claim 20 recites, among other things, a handheld, baitfish catching device including "a handle having a first end and an opposing second end" and "a body of unitary construction defining an interior chamber, said first end of said handle being connected to a middle potion of said body, said body including a first end, an opposing second end, and an aperture-free sidewall extending between said first end and said second end . . . said second end of said body including a fixed, end wall, defining a single, second unobstructed opening having a second diameter that is less than the first diameter and less than the size of the baitfish, said body being non-rotatable with respect to said handle." The combination of Johnson, DePoe and Garrison does not disclose or suggest such subject matter.

As stated above, Johnson fails to disclose or suggest a handle that is connected midway between opposing ends of a trap or to a middle portion of a fish trap because such a construction would not effectively hold a fish within the trap during use. DePoe discloses a fishing net and therefore does not remedy the deficiencies of Johnson.

Garrison does not disclose any type of handle connected to the minnow trap. Even assuming arguendo that a handle can be attached to the minnow trap in Garrsion, such a handle would not be attached to a middle portion of the tubular body

because doing so would lead to the same problems identified above for Johnson. Thus, Garrison fails to remedy the deficiencies of Johnson and DePoe.

For at least these reasons, Applicant submits that amended claims 10, 13 and 20, and the claims that depend respectively therefrom, are each patentably distinguished from the cited combination and in condition for allowance.

Applicant submits that in view of the above-identified amendments and remarks, the claims in their present form are patentably distinct over the art of record. Allowance of the rejected claims is respectfully requested. Alternatively, the claims are placed in better condition for appeal. Should the Examiner discover there are remaining issues which may be resolved by a telephone interview, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By
Christopher S. Hermanson
Reg. No. 48,244

May 8, 2010
300 South Wacker Drive
Suite 2500
Chicago, Illinois 60606
Telephone: (312) 360-0080
Facsimile: (312) 360-9315
Customer No. 24978